Supreme Court, U.S.
JUN 27 1975
MICHAEL RODAK, JR., CLERK

IN THE

Supreme Court of the United States

October Term, 1974

No. 74-1644

JOHN C. SHEEHAN,

Petitioner,

v.

FRANK P. DOYLE, *et al.*,

Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

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IN THE

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No. .....

JOHN C. SHEEHAN,

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FRANK P. DOYLE, *et al.*,

Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

Petitioner, John C. Sheehan, prays that a Writ of Certiorari be granted to review the judgment of the United States Court of Appeals for the First Circuit entered in this proceeding on March 31, 1975.

Citations to Opinions Below

The Opinion of the Court of Appeals for the First Circuit is reported at —— F.2d ——; 185 U.S.P.Q. 489 (1975) and is reproduced in Appendix A hereto, *infra.*

The opinion of the District Court for the District of Massachusetts, unofficially reported at 184 U.S.P.Q. 291, is printed in Appendix C, *infra,* page 10a.

Jurisdiction

The judgment of the United States Court of Appeals for the First Circuit was entered on March 31, 1975 (Appendix B, *infra,* page 9a). The present petition for certiorari was filed within 90 days of the original judgment.

This Court's jurisdiction is invoked under 28 U.S.C. §1254(1).

Question Presented

Does 35 U.S.C. §24, which provides in relevant part:

> "The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent Office."

mean that the federal courts are statutorily authorized and required to assist a party in contested Patent Office interference proceedings to obtain as a matter of right the full range of discovery contemplated by the Federal Rules of Civil Procedure?

Statutory Provision Involved

§24 Subpoenas, witnesses

The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent Office, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. *The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent Office.*

Every witness subpoenaed and in attendance shall be allowed the fees and traveling expenses allowed to witnesses attending the United States district courts.

A judge of a court whose clerk issued a subpoena may enforce obedience to the process or punish disobedience as in other like cases, on proof that a witness, served with such subpoena, neglected or refused to appear or to testify. No witness shall be deemed guilty of contempt for disobeying such subpoena unless his fees and traveling expenses in going to, and returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena; nor for refusing to disclose any secret matter except upon appropriate order of the court which issued the subpoena. [35 U.S.C. §24 (1952) (emphasis supplied)]

Statement of the Case

This case arises from a pending U.S. Patent Office interference proceeding[1] declared under the provisions of 35 U.S.C. §135 between an issued patent of petitioner and a patent application of respondents and involves the petitioner's use of 35 U.S.C. §24 in seeking discovery in aid of the interference proceeding.

1. The course of proceedings in an interference is described in footnote 1 of the Opinion of the Court below (Appendix A).

Petitioner, John C. Sheehan, is the inventor of United States patent No. 3,159,617, assigned to Arthur D. Little, Inc., a corporation of Massachusetts. The subject matter of the patent is a method for producing penicillins, both "natural" and synthetic.

Respondents are British subjects and residents of Great Britain and are the applicants of a pending U.S. patent application assigned to Beecham Research Laboratories Ltd. (BRL), a British corporation.

The Patent Office declared an interference between respondents' application and petitioner's patent solely on the basis of certain self-serving *ex parte* affidavits filed on behalf of respondents in 1969. The affidavits described experimental work undertaken by BRL in support of its allegations that the disclosure of the Sheehan patent was inoperable, i.e., could not be re-run in the laboratory to produce the compounds obtained by Sheehan, particularly a key intermediate compound 6-APA. Petitioner has challenged the sufficiency of the laboratory procedure and identifying tests used by BRL.

Petitioner, in the interference proceeding, has raised issues relating to the candor of BRL in failing to use, or even discuss, meaningful identification techniques which were available for establishing the presence of the key intermediate 6-APA which they allege was not produced following Sheehan's teachings. Specifically, important questinos were raised by petitioner as to whether the products obtained by affiants were tested using paper chromatographic separation and identification procedures—which is a sensitive procedure that had been developed by BRL

at least as early as 1959. Petitioner has also pointed out to the Patent Office, that although the affiants had stated that extensive experimental work was conducted in Great Britain in accordance with the disclosure of the Sheehan patent, conflicting results which were reported on several runs were left unexplained in the affidavits. These issues have never been answered by BRL.

Petitioner accordingly sought document discovery from respondents and BRL under the provisions of 35 U.S.C. §24 by means of Rule 34 of the Federal Rules of Civil Procedure. Respondents could not be subpoenaed under Rule 45 because they are aliens not present in the United States. Petitioner requested that respondents produce certain background documents and materials relating to the *ex parte* affidavits and the experimental work of BRL to determine whether they had complied with the requirements of strict candor that an applicant must meet in his dealings with the Patent Office. The documents and materials requested are described in petitioner's Rule 34 request attached as Appendix D, *infra*, page 11a.

The District Court of Massachusetts, on October 9, 1974, under the then-prevailing construction of 35 U.S.C. §24, ordered respondents to produce the documents and materials sought. On appeal, the U.S. Court of Appeals for the First Circuit reversed the order of the District Court, holding that 35 U.S.C. §24 does not confer jurisdiction on the District Court, acting on its own, to grant Rule 34 discovery directly, but rather applies only to the use of subpoenas (as provided in Rule 45) in aid of discovery authorized by the Patent Office. The First Circuit

specifically adopted the reasoning supporting the recent ruling by the Third Circuit in *Frilette* v. *Kimberlin*, 508 F.2d 205 (Jan. 27, 1975) (*en banc*). In the *Frilette* decision, the Third Circuit not only reversed its own prior decisions, but adopted an interpretation of the statute which at the time squarely conflicted with the decisions of four other Circuit Courts of Appeals (Second[2], Fifth[3], Seventh[4] and Tenth[5]) and the district courts of three additional circuits (Western District of Michigan[6], Northern District of Oklahoma[7], District of Columbia[8] and District of Massachusetts[9]).

Petitioner has himself been caught in this relatively recent shift in judicial construction of 35 U.S.C. §24. As a result of discovery proceedings initiated against petitioner by respondent in the District of Massachusetts in 1973 (prior to *Frilette*) that court ordered compliance with a subpoena *duces tecum*. The District Court had ordered the discovery under the then-prevailing rulings which had uniformly held that 35 U.S.C. §24 authorized the federal courts to grant broad discovery to interference parties. (See the opinion of Judge Garrity of November 20, 1973,

2. *Babcock & Wilcox Co.* v. *Combustion Engineering, Inc.*, 430 F.2d 1177 (2d Cir. 1968), *aff'g mem.* 314 F. Supp. 235 (D. Conn. 1968).

3. *Gladrow* v. *Weisz*, 354 F.2d 464 (5th Cir. 1965).

4. *Natta* v. *Zletz*, 379 F.2d 615 (7th Cir. 1967).

5. *Natta* v. *Hogan*, 392 F.2d 686 (10th Cir. 1968).

6. *Korman* v. *Shull*, 184 F. Supp. 928 (W.D. Mich. 1960).

7. *Hogan* v. *Zletz*, 151 USPQ 103 (N.D. Okla. 1966).

8. *Lomex* v. *Kihara*, 175 USPQ 538 (D.D.C. 1972).

9. *Sheehan* v. *Doyle*, 181 USPQ 64 (D. Mass. 1973).

Appendix E, *infra*, page 15a.) No appeal was taken from this order, and respondents obtained extensive discovery from petitioner.

Reasons for Granting the Writ

I

The decision below is the most recent example, and is representative, of the continuing and deepening conflict which is developing between the decisions of the Courts of Appeals which have interpreted 35 U.S.C. §24.

The judicial construction of 35 U.S.C. §24 by the court below is in direct and irreconcilable conflict with four of the five Circuit Courts which had previously considered the question.

The decision below adopted the arguments and analysis of the Third Circuit in *Frilette et al.* v. *Kimberlin et al.*, 508 F.2d 205 (3d Cir. 1975) (*en banc*). A Petition for Certiorari was filed from the decision in *Frilette* (No. 74-1156), and in a companion Third Circuit case, *Duffy* v. *Barnes et al.* (No. 74-1200). The following rulings by this Court were entered on May 19, 1975:

No. 74-1156: "The petition for a writ of certiorari is denied. Mr Justice Douglas and Mr. Justice White would grant certiorari. Mr. Justice Powell took no part in the consideration or decision of this petition."

No. 74-1200: "The petition for writ of certiorari is denied. Mr. Justice Douglas would grant certiorari."

There can be no doubt that the court below recognized that it was adopting a construction of 35 U.S.C. §24 which was to be at odds with the controlling interpretation of that provision by four other Circuits around the country and which the Third Circuit had only recently reached by reversing its own seven-year stand on 35 U.S.C. §24. The decision below admitted that when the case was argued on December 2, 1974,

> "* * * it was accepted among the circuits that had passed on the matter that section 24 authorized discovery beyond that permitted by the Patent Office, and in particular the production of documents from a party by means of a Rule 34 motion.",

citing the decisions of the Second, Third, Fifth, Seventh and Tenth Circuits.

However, the issue presented to the First Circuit was one of first impression, and it did not face the difficult questions which confronted the Third Circuit in *Frilette*, and which apparently prompted Circuit Judge Weis to use the phrase to "bite the bullet" (508 F.2d at 207) in describing that Court's action in overruling its prior decision in *In re Natta*, 388 F.2d 215 (1968).

The fact that the First and Third Circuits have recently adopted a narrow construction of 35 U.S.C. §24, serves only to highlight the disparity of views between these two Circuits and the views of the four other Circuits which have broadly interpreted the statutory authority of §24.

The separate dissenting opinions of Judge Van Dusen and of Judge Adams (with which Judge Van Dusen concurred) clearly point up the problems created by the majority opinion in the *Frilette* case which was adopted by the decision below.

We respectfully submit that the conflict between the Circuits is firmly set on this narrow issue of law and that it should be promptly resolved by this Court.

II

The conflicts between the Circuits respecting the jurisdiction conferred by 35 U.S.C. §24 is likely to lead to further and serious injustice.

The likely and predictable result of the conflict between the Circuits respecting the jurisdiction under 35 U.S.C. §24 of the federal district courts to afford discovery to opposing parties in contested Patent Office proceedings is that testimony and evidence will be discoverable depending upon the fortuitous happenstance of its geographical location.

Thus, the various parties to a single proceeding can be subjected to completely different burdens of producing evidence and will result in unequal opportunities for conducting their respective inquiries into the facts relating to their opponents' case. Petitioners have, in fact, experienced this unfairness in prior discovery proceedings relating to the same patent interference. Respondents Doyle et al., being the other party to the interference, initiated discovery under 35 U.S.C. §24 in 1973 when there was no conflict between the Circuits on the question of jurisdiction and the reported decisions of the federal courts had generally

favored broad-based Federal Rules discovery. In apparent reliance on this uniform and consistent decisional authority the District Court for the District of Massachusetts entered an order authorizing discovery with which petitioner complied. At that time (i.e., early 1974), there was little basis for recommending that an appeal be taken from the discovery order. Petitioner then instituted discovery against the respondents, which discovery was ordered by the District Court under the then-prevailing law over the respondents' objection, and the appeal to the court below as taken. However, the issues of personal jurisdiction and venue relating to non-resident aliens which prompted the appeal by respondents did not form the bases of the decision below.

Furthermore, it cannot be disputed that the patent interference proceedings within which the decision below arose are anything less than a full trial, albeit conducted under the auspices of an administrative agency. On many occasions this Court has emphasized the importance of the federal discovery rules to making "a trial less a game of blind man's bluff and more a fair contest with the basic issues and facts disclosed to the fullest practicable extent." *United States* v. *Proctor & Gamble Co.*, 356 U.S. 677 at 682-683 (1958); *Hickman* v. *Taylor,* 329 U.S. 495 at 501 (1947).

The present broad construction of 35 U.S.C. §24 by the Courts of Appeals of the Second, Fifth, Seventh and Tenth Circuits will permit a party to develop the relevant facts necessary to permit the Patent Office to best discharge its adjudicative responsibilites. The interpretation of 35

U.S.C. §24 adopted below will frustrate a litigant's access to information essential to a full and fair presentation of all issues relevant to the Patent Office's determination.

There can be little doubt that this conflict will also prompt dissatisfied parties to interference-related discovery proceedings in district courts located in Circuits other than the First and Third to take appeals. Each Circuit will again have to establish its position with respect to the construction of 35 U.S.C. §24. Even if the Circuits were to eventually reach a uniform conclusion, this is a slow, costly and tortuous route to impose upon the development of the law. It will result in unnecessary burdens not only to the parties, but also to the district and Circuit courts, and will unduly burden the public by delaying the final resolution of patent interference proceedings and ultimately the issuance of patents.

III

The decision below constitutes an improper refusal to accept the jurisdiction conferred upon the federal courts by Congress.

The decision below disregards the plain meaning of the following language of 35 U.S.C. §24:

> "The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent Office."

The construction of this language from the statute by a majority of judicial authority which has previously considered it, leads to the conclusion that the federal courts

are invested by Congress with a mandatory jurisdiction to consider on their merits applications for discovery in interference proceedings pending before the Patent Office tribunal. Assuming that the interpretation which has been uniformly and consistently applied in the Second, Fifth, Seventh and Tenth Circuits is proper, then the decision below clearly misapprehends the intention of Congress. Where Congress has determined to invest the federal courts with such jurisdiction and authority, that jurisdiction must be exercised. For the federal courts to do otherwise would be disruptive of the delicate balance of powers between the executive, legislative and judicial branches of our system of government. In an opinion written prior to the decision of the Third Circuit in *Frilette* which was adopted by the court below, District Judge Coolahan considered the constitutional implications in connection with a determination of the jurisdictional obligations of the courts under 35 U.S.C. §24 and stated:

"The district court may not defer to the Board[4] by declining to exercise its jurisdiction under 35 U.S.C. §24, as it has always been the law that federal courts may not refuse jurisdiction conferred by the Constitution and statutes of the United States.[5]"

* * *

"5. Cohens v. Virginia, 19 U.S. (6 Wheat.) 264 (1821), in which Chief Justice Marshall, with characteristic vigor and directness, ruled that the Supreme Court 'must take jurisdiction, if it should. * * * We have no more right to decline the exercise of jurisdiction which is given, than to usurp that which is not given. The one or the other would be treason to the constitution.' Id. at 404." *Babcock & Wilcox Co.* v. *Foster Wheeler Corp.*, 173 U.S.P.Q. 480 at 483 (D.N.J. 1972)—[All but footnote 5 omitted.]

In view of the likelihood that the decision below represents an unconstitutional abandonment of compulsory jurisdiction under a federal statute, this Court should grant review.

Conclusion

For all of the reasons stated, it is respectfully requested that this Court grant the present petition for a writ of certiorari to the First Circuit Court of Appeals to review the decision below.

Respectfully submitted,

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APPENDIX

Appendix A

Opinion of Court Below

UNITED STATES COURT OF APPEALS

FOR THE FIRST CIRCUIT

No. 74-1318

JOHN C. SHEEHAN,
Plaintiff, Appellee,

v.

FRANK P. DOYLE *et al.*,
Defendants, Appellants.

APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS

Before COFFIN, *Chief Judge,*

McENTEE and CAMPBELL, *Circuit Judges.*

Albert L. Jacobs, Jr., with whom *Jacobs & Jacobs, P.C.*, *Owen F. Clarke, Jr.*, and *Sullivan & Worcester* were on brief, for appellants.

Thomas E. Spath, with whom *N. Dale Sayre, McLean, Boustead & Sayre, Robert J. Horn, Jr., Kenway and Jenney* were on brief, for appellee.

March 31, 1975

CAMPBELL, *Circuit Judge.* This appeal concerns the authority of the District Court for the District of Massachusetts to order discovery in aid of a patent interference

proceeding being conducted before the Board of Patent Interferences in Arlington, Virginia.

Doyle (a name used for three nonresident aliens) is engaged in an interference in the United States Patent Office against Sheehan, a Massachusetts resident. *See* 35 U.S.C. §135. At issue is whether Doyle or Sheehan is the first inventor of processes for the production of penicillin. Doyle has applied for a United States patent, Sheehan already having been granted one covering the same subject matter.

One might suppose that the scope of discovery for use in an interference[1] would be determined by the Patent Office

1. An interference—an administrative proceeding in the Patent Office—follows a distinct format. After parties have preliminarily stated their positions, 37 C.F.R. §§1.215-1.223, and the period for filing motions has been set, *id.* §§1.231-1.244, the Board of Patent Interferences establishes a schedule for the parties' presentation of evidence by means of deposition, affidavit, or stipulation, *id.* §1.251. The patent applicant who was later in time (the "junior party") is required to produce his evidence first and carries the burden of disproving the order of application. *Id.* §1.257. Testimony is to be taken before an officer authorized to administer oaths, *id.* §1.274, and must always be filed in the Patent Office, *id.* §1.278. If objections are made to the witness or evidence, the evidence shall be taken anyway and the objection noted by the officer. *Id.* §1.275(d). In determining whether to receive or exclude evidence, the Patent Office will "strictly" apply "the established rules of evidence". *Id.* §1.286.

The discovery provision for interferences, Rule 287, only requires a party to furnish his opponent with lists of things, names of witnesses, and copies of documents "upon which the party intends to rely". *Id.* §1.287(a). The senior party—Sheehan in this case—need not provide such materials to the junior party until the junior party has completed taking his testimony. There is no discovery of right of matters which might build an affirmative case for the discovering party or which might undercut the opponent's case-in-chief. However, the Board may grant further discovery privileges, within the scope of the Federal Rules of Civil Procedure, at any time during the proceedings "upon a showing that the interest of justice so requires". *Id.* §1.287(c).

or at least coordinated with the administrative proceeding within its jurisdiction; and Congress has in fact conferred statutory authority upon the Commissioner of Patents to "establish rules for taking affidavits and depositions required in cases in the Patent Office", 35 U.S.C. §23, and the Commissioner has adopted certain rules, *see* note 1 *supra*. But in section 24, Congress has also conferred certain powers upon district courts. Historically section 24 developed to provide for the issuance of subpoenas to compel testimony and evidence required in Patent Office interferences; but a sentence in section 24 inserted by Congress in 1952 has been construed by a number of courts also to allow parties to an interference to obtain at any time broad-based discovery in district courts in separate, self-contained proceedings.[2] *See infra*. Such discovery goes on outside the

2. Section 24, 35 U.S.C. §24, provides in its entirety,

"Subpoenas, witnesses"

"The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent Office, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. *The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesss and to the production of documents and things shall apply to contested cases in the Patent Office.*

Every witness subpoenaed and in attendance shall be allowed the fees and traveling expenses allowed to witnesses attending the United States district courts.

A judge of the court whose clerk issued a subpoena may enforce obedience to the process or punish disobedience as in other like cases, on proof that a witness, served with such subpoena, neglected or refused to appear or to testify. No witness shall be deemed guilty of contempt for disobeying such subpoena unless his fees and traveling expenses in going to, and returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena; nor for refusing to disclose any secret matter except upon appropriate order of the court which issued the subpoena." [Emphasis supplied.]

ambit of the Patent Office proceeding and beyond the scope permitted without special approval under its rules.

Citing section 24 and bypassing the Patent Office's procedures, Doyle brought an independent action in the District Court for the District of Massachusetts to obtain discovery from Sheehan under the Federal Rules of Civil Procedure. The court issued a subpoena duces tecum against Sheehan and, after hearing Sheehan's objections, refused to quash the subpoena and directed Sheehan to produce the requested records and appear to be deposed. In addition to the discovery of Sheehan, Doyle's counsel was able to obtain from the court subpoenae duces tecum against two organizations, also located in Massachusetts, having an interest in the Sheehan patent. Doyle's goal in these ancillary proceedings has been to discover evidence that an abandoned Sheehan patent application in 1957, while disclosing some processes, did not disclose enough to enable Sheehan to claim first invention to the processes for which Sheehan obtained the disputed patent in 1959 and as to which Doyle has a claim to invention dating from late 1957.

While Doyle's discovery was in progress, Sheehan, also invoking section 24, filed a request under Rule 34, Fed. R. Civ. P.,[3] for the production of documents from Doyle and

3. Rule 34(a), Fed. R. Civ. P., provides in pertinent part:

> "Any party may serve on any other party a request (1) to produce and permit the party making the request, or someone acting on his behalf, to inspect and copy, any designated documents * * * or to inspect and copy, test, or sample any tangible things which constitute or contain matters within the scope of Rule 26(b) and which are in the possession, custody or control of the party upon whom the request is served. * * *"

Rule 26(b) generally allows a party to obtain discovery of "any matter, not privileged, which is relevant to the subject matter involved in the pending action". Rule 26(b) further provides, "It is not ground for objection that the information sought will be inadmissible at the trial if the information sought appears reasonably calculated to lead to the discovery of admissible evidence."

his assignee, Beecham Research Laboratories, Inc. (BRL), a British corporation and the real party in interest. Sheehan sought documents of tests and evaluations, made by BRL and to be introduced in interference testimony, concerning the sufficiency of the Sheehan disclosure in its abandoned 1957 application. After considering arguments for and against compelling discovery from the nonresident aliens, the district court ordered Doyle and BRL to produce those documents sought that were not privileged. From this order Doyle now appeals. Doyle objects to the order on grounds of lack of personal jurisdiction and proper venue, as he is a nonresident alien with no ties to Massachusetts. We do not reach these arguments because we hold that section 24 does not confer jurisdiction upon the district court, acting on its own, to grant Rule 34 discovery directly, whether against a nonresident alien or a resident citizen.

A threshold question is the appealability of the district court's discovery order. A discovery order is not usually "final"—and hence not immediately appealable—as the litigation in conjunction with which the discovery is sought is still pending in the district court. 28 U.S.C. §1291. Discovery here, however, is ancillary to the interference in Arlington, Virginia, at the Patent Office, and nothing else was pending at the time in the Massachusetts court. The instant order, therefore, concluded—at least for the moment—the business of the district court. Thus, while the usual policy against piecemeal appellate review dictates otherwise, we must regard the order as final and appealable. *See Natta* v. *Hogan,* 392 F.2d 686, 689 (10th Cir. 1968). (Indeed, Doyle has sought more discovery since this appeal was heard, and the district court's next ruling would likewise be final and appealable.)

Appendix A

The next issue is whether section 24 authorizes the Rule 34 discovery Sheehan seeks. When this appeal was argued, it was accepted among the circuits that had passed on the matte. that section 24 authorized discovery beyond that permitted by the Patent Office, and in particular the production of documents from a party by means of a Rule 34 motion. *See, e.g., Babcock & Wilcox Co.* v. *Combustion Engineering, Inc.*, 430 F.2d 1177 (2d Cir. 1968), *aff'g mem.* 314 F. Supp. 235 (D. Conn. 1968); *In re Natta*, 388 F.2d 215 (3d Cir. 1968); *Natta* v. *Hogan*, 392 F.2d 686 (10th Cir. 1968); *Natta* v. *Zletz*, 379 F.2d 615 (7th Cir. 1967); *Gladrow* v. *Weisz*, 354 F.2d 464 (5th Cir. 1965). However, subsequent to argument the Third Circuit ruled, en banc, that section 24 merely confers upon district courts jurisdiction to issue, in aid of the interference, subpoenas as provided in Fed. R. Civ. P. 45(a), (b), (c), (d)(2) & (3), and (f).[4] *Frilette* v. *Kimberlin*, 508 F.2d 205 (3d Cir. 1975) (en banc). The practical effect of this ruling is to permit the compelling of testimony and evidence by the district court which is sought at the proper stage of the Patent Office proceeding, and also to allow the issuance of subpoenas in aid of discovery as authorized by the Patent Office but not otherwise. *See* note 1 *supra*.

The Third Circuit's decision was a reversal of its position in *In re Natta, supra*, and a vindication of Judge (now Chief Judge) Seitz's dissenting opinion in the earlier case. 388 F.2d at 221-23. Unlike that circuit, this circuit has never previously passed on the matters.

4. Rule 45(d)(1), Fed. R. Civ. P., authorizes the compelling of discovery within the scope of Rule 26(b), *see* note 3 *supra*, and therefore is inconsistent with the existing Patent Office discovery rules for interferences.

Appendix A

We believe that the broad reading which courts have given section 24 over recent years goes beyond what Congress could reasonably have had in mind. The unfortunate effect is to generate self-contained discovery proceedings out of joint with the administrative proceeding to which, ostensibly, they are linked. The arguments and analysis, which we adopt and need not repeat, are well set forth in Judge Seitz's dissent in *In re Natta* and in *Frilette*. We agree that section 24 is simply a provision giving teeth, through the courts' subpoena power, to authority conferred upon the Commissioner of Patents. Such a reading is consistent with the fact that section 23 confers general authority upon the Commissioner of Patents to promulgate rules with respect to depositions and affidavits; with the tenor of section 24; and with the absence of evidence that any sweeping substantive change was intended in the 1952 redraft of section 24 which introduced the sentence in question. If Congress had intended to erect a freewheeling discovery vehicle totally outside the control of the Patent Office, one would have expected some inkling in the legislative history.

Our decision does not have the effect of precluding broad-based Federal Rules discovery in patent interferences to the extent permitted by the Commissioner, whose rules presently allow such discovery "if justice so requires". *See* note 1 *supra*. Judicial subpoenas that may appropriately aid in any such authorized discovery, as well as to obtain testimony and evidence for use in the proceeding in progress, remain available. Our decision merely precludes use of federal courts as alternative forums of

first resort rather than as forums acting strictly in aid of the primary proceeding.

Sheehan contends that the effect of a decision following the Third Circuit would be to insulate nonresident aliens from ancillary discovery, since a subpoena cannot be served upon them. But ancillary judicial discovery is unnecessary as to parties, since the Commissioner has the power to compel testimony or evidence by the threat of dismissing the application. *See* 37 C.F.R. §1.259. The Patent Office has no power to compel the attendance of nonparty witnesses or to enforce the production of evidence from them, and this need was apparently the main reason that Congress conferred ancillary jurisdiction upon federal courts, with their subpoena power and threat of contempt.

It may nevertheless seem unfair in this case to deny Sheehan discovery against Doyle after Doyle has had the advantage of extensive discovery from Sheehan under section 24.[5] However, we are not inclined to impose our notions of fairness on the agency which has been delegated primary authority to control the interference. Moreover, evidence not taken in accordance with the Patent Office rules will not be considered in determining the interference, 37 C.F.R. §1.271, and in any event a party aggrieved may litigate through *de novo* proceedings in the district court, 35 U.S.C. §135.

Reversed. No costs.

5. Even during the junior party's testimony period, the junior party may not plunge into the senior party's direct case by issuing subpoenas to the senior party. Such a course would be contrary to the set order of taking testimony.

Appendix B

Judgment of the Court Below

UNITED STATES COURT OF APPEALS

FOR THE FIRST CIRCUIT

No. 74-1318

JOHN C. SHEEHAN,
Plaintiff, Appellee,

v.

DOYLE, *et al.*,
Defendants, Appellants.

JUDGMENT

Entered March 31, 1975

This cause came on to be heard on appeal from the United States District Court for the District of Massachusetts, and was argued by counsel.

Upon consideration whereof, It is now here ordered, adjudged and decreed as follows: The order of the District Court is reversed. No costs.

By the Court:

/s/ Dana H. Gallup
Clerk.

[cc: Messrs. Jacobs and Spath.]

Appendix C

Opinion of District Court

UNITED STATES DISTRICT COURT

District of Massachusetts

[caption omitted]

August 9, 1974

Garrity, J. Upon consideration of the motion to compel discovery and the memoranda, defendants Doyle et al. are ordered to produce those documents not privileged which the plaintiff Sheehan has sought under 35 U.S.C. §24 and Rule 34, Fed. R. Civ. P. In our view these proceedings are not materially different from those in *Vogel* v. *Jones*, 3 Cir. 1971, 443 F.2d 257. If they wish, Doyle et al. may produce these documents in New York rather than Boston.

Doyle et al. shall identify those documents as to which privilege is claimed and state the basis therefor on or before August 20, 1974. Doyle et al. should specifically address the case of *Technitrol, Inc.* v. *Digital Equipment*, N.D. Ill. 1974, 181 U.S.P.Q. 731, if a claim of privilege should raise questions discussed therein.

W. Arthur Garrity, Jr.
United States District Judge

Appendix D

Rule 34 Motion

IN THE

UNITED STATES DISTRICT COURT

For the District of Massachusetts

[caption omitted]

John C. Sheehan, pursuant to 35 U.S.C. §24 and Rule 34 of the Federal Rules of Civil Procedure, hereby requests:

(a) The party Doyle et al. (Frank Peter Doyle, John Herbert Charles Nayler and George Newbolt Rolinson), and

(b) Beecham Research Laboratories, Ltd., the assignee of the party Doyle et al., as follows:

1. To produce and to permit the party Sheehan, or someone acting in his behalf, to inspect and copy all documents within the possession, custody or control of the above party Doyle et al., Beecham Laboratories, Ltd. and its divisions or its related companies, or any of the attorneys, agents or assigns thereof, relating and/or referring to:

(a) evaluations of the operability or sufficiency of the disclosure of U.S. Patent 3,159,617 to Sheehan, including, but not limited to evaluations of the examples of the patent;

(b) all documents relating and/or referring to, or relied on in the preparation of the affidavits of

John Herbert Charles Nayler, Maurice Soulal and Robert Robinson filed in 1965 in the U.S. Patent Office during the prosecution of Doyle et al. application for patent filed July 13, 1959, Serial No. 826,491;

(c) all documents relating and/or referring to, or relied on in the preparation of the affidavits of John Herbert Charles Nayler and John P. Clayton (including the Appendices attached thereto) filed in 1970 in the U.S. Patent Office during the prosecution of Doyle et al. application for patent filed September 22, 1969, Serial No. 870,771, including but not limited to the work described in these affidavits; and

(d) all documents relating or referring to tests to be used, or capable of being used, and the results of such tests obtained in connection with the evaluations of subsection (a) above and the work described in the affidavits of subsection (c) above, to identify the compounds (i) penicillin V, (ii) 6-aminopenicillanic acid (6-APA) (including its alkali metal and acid addition salts), and (iii) the intermediate compounds prepared in accordance with the step-wise synthesis disclosed in U.S. Patent 3,159,617 to Sheehan and denominated as compounds I, II, III and VIII in that disclosure.

2. To produce and to permit the party Sheehan, or someone acting in his behalf, to inspect, and withdraw as a sample for testing, a reasonable and adequate quantity of

each of the following materials which are within the possession, custody or control of the above party Doyle et al., Beecham Research Laboratories, Ltd. and its divisions or its related companies, or any of the attorneys, agents or assigns thereof:

(a) Chemical product designated as BRL 7750 (see affidavits of John Herbert Charles Nayler, page 3, and of John P. Clayton, page 3, filed in patent application U.S.S.N. 870,771)

(b) Chemical products designated as BRL 7782, 7916, 7954, 7820, 7917 and 7955 (see affidavit of John P. Clayton, page 6 through 10, filed in patent application U.S.S.N. 870,771).

3. Any documents produced under any one of the subparagraphs of paragraph 1 above, but falling within the scope of subsequent subparagraphs need be produced only once.

4. As used above, the term "documents" includes writings, graphs, charts, photographs, phono-records and other data compilations from which information can be obtained, translated, if necessary, by the respondent through detection devices in reasonably usable form, and also all laboratory notebooks, logbooks, reports, all interdepartmental memoranda, instructions, letters, records of oral communications and discussions, and all drafts of documents.

5. If a privilege is to be claimed with respect to any of the documents included within the scope of the above production request, each of such documents for which a privilege is claimed shall be identified as follows:

Appendix D

(a) the date appearing on such document and if no date appears thereon, the answer shall so state;

(b) the name and title of the person who signed such document and if it was not signed, the answer shall so state and shall give the name and title of the person or persons who prepared it;

(c) the name and title of the person to whom such document was addressed and the name and title of each person, other than such addressee, to whom such document or a copy thereof was sent; and

(d) the basis for the claim of privilege with respect to each of the documents so identified.

It is requested that the aforesaid production be made on the first day of April, 1974, at 10:00 in the A.M. at the offices of Kenway and Jenney, 24 School Street, Boston, Massachusetts.

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Feb. 27, 1974

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[Certificate of Service omitted in printing.]

Appendix E

District Court Opinion in Doyle Discovery

UNITED STATES DISTRICT COURT

DISTRICT OF MASSACHUSETTS

SHEEHAN v. DOYLE *et al.*

E.B.D. No. 73-140
Decided Nov. 20, 1973

Upon consideration of plaintiff's motion under Rules 26(c) and 45 to quash the subpoena duces tecum addressed to the plaintiff on September 19, 1973, and supporting and opposing memoranda, it is ordered that the motion be denied because the documents requested are clearly relevant and material, plaintiff has shown no prejudice, and allowance of the motion would further delay resolution of the merits of the controversy and invite further procedural skirmishes.

In our opinion, enactment of Rule of Practice 287 (1971) does not diminish the court's jurisdiction under 35 U.S.C. §24. We see nothing in Frilette et al. v. Kimberlin, D. Del. 1973, 358 F.Supp. 493, 178 USPQ 387, indicating that Judge Wright would deny resort to §24 in a situation such as this. Babcock & Wilcox Co. v. Foster Wheeler Corp., 1972, 173 USPQ 480, also relied upon by plaintiff, suggests that where Rule 287 discovery procedures have been ineffective, resort to §24 should be available.

W. ARTHUR GARRITY
United States District Judge

Supreme Court, U. S.
FILED
JUL 24 1975
MICHAEL RODAK, JR., CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1974

No. 74-1644

JOHN C. SHEEHAN,

Petitioner,

—v.—

FRANK P. DOYLE, *et al.*,

Respondents.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1974

No. 74-1644

JOHN C. SHEEHAN,

Petitioner,

—v.—

FRANK P. DOYLE, *et al.*,

Respondents.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

Statement of the Case

Petitioner is requesting this Court to review the judgment of the United States Court of Appeals for the First Circuit which held that Petitioner could not take discovery from Respondents who are nonresident aliens under Rule 34 of the Federal Rules of Civil Procedure in an ancillary proceeding allegedly brought under 35 U.S.C. 24.

Petitioner, John C. Sheehan, attempted to take discovery under Rule 34 of the Federal Rules of Civil Procedure from Frank Peter Doyle, John Herbert Charles Nayler and George Newbolt Rolinson, who are all British subjects and are nonresident aliens. Petitioner and Respondents are

involved in an interference proceeding in the United States Patent and Trademark Office. Petitioner is a United States citizen residing in Lexington, Massachusetts. Respondents are all residents of Great Britain and have had no contacts with the State of Massachusetts except for their prior application to the District Court in Massachusetts for a subpoena duces tecum which was served on Petitioner after he had refused to produce documents pursuant to a request under Rule 34 of the Federal Rules of Civil Procedure.

As stated on page 5 of Petitioner's Petition for a Writ of Certiorari, Respondents could not be subpoenaed because they are aliens not present in the United States.

Summary of Argument

I. There is no conflict among any of the Courts of Appeals with respect to obtaining discovery under the Federal Rules of Civil Procedure from a nonresident alien.

II. The decision of the First Circuit Court of Appeals was correct.

III. The judgment of the First Circuit Court of Appeals is correct on three additional grounds beyond the specific reasons set forth by that Court for reaching its conclusion.

REASONS FOR DENYING THE WRIT

I.

There Is No Conflict Among Any of the Courts of Appeals With Respect to Obtaining Discovery Under the Federal Rules of Civil Procedure From a Nonresident Alien.

Petitioner has alleged as the first reason for granting the Writ that there is a conflict among the Courts of Appeals relating to discovery for use in Patent Office interferences. It must be remembered that the present case involves the attempt by Petitioner to take discovery under Rule 34 of the Federal Rules of Civil Procedure from three nonresident aliens who reside in Great Britain and who were not and could not be subpoenaed.

An analysis of the cases relied upon by Petitioner on page 6 of his Petition for a Writ of Certiorari clearly demonstrates that the facts of each of the cases relied upon differ materially from that of the present case. In *Babcock & Wilcox Co.* v. *Combustion Engineering, Inc.,* 430 F.2d 1177 (C.A. 2 1968), which affirmed 314 F. Supp. 235 (D. Conn. 1968), both parties were United States corporations and Babcock & Wilcox had served six subpoenas on employees of Combustion Engineering, Inc. Combustion Engineering then brought a motion to vacate the six subpoenas which had been served. The Second Circuit affirmed the District Court's denial of the motion to vacate the subpoenas.

In *Gladrow* v. *Weisz,* 354 F.2d 464 (C.A. 5 1965) production of documents was sought during Weisz's cross-examination of Gladrow. Gladrow refused to produce certain

documents and Weisz then moved in a District Court for an order requiring Gladrow to produce the documents. The District Court's order granting the motion to compel production was affirmed by the Fifth Circuit.

In *Natta* v. *Zletz,* 379 F.2d 615 (C.A. 7 1967), Natta sought production of documents from the files of Standard Oil Company of Indiana, a United States company. The Seventh Circuit directed that such production be effected.

In *Natta* v. *Hogan,* 392 F.2d 686 (C.A. 10 1968), Natta brought a proceeding in the District Court for the Northern District of Oklahoma against Phillips Petroleum Co., a United States company, requesting discovery under Rule 34 of the Federal Rules of Civil Procedure. The Tenth Circuit affirmed the order for production.

In *Korman* v. *Shull,* 184 F. Supp. 928 (D.C. W.D. Mich. 1960), H. B. Allen, Secretary of the Upjohn Company and Hogg and Korman, who were parties, were served with subpoenas. In that case, the District Court decided, *inter alia,* that good cause for the production of documents was not shown and granted the motion to quash.

In *Hogan* v. *Zletz,* 151 U.S.P.Q. 103 (D.C. N.D. Okla. 1966), the District Court for the Northern District of Oklahoma found that service of process on Phillips Petroleum Company, a United States corporation, was satisfactory and directed the production sought by Zletz from that company.

In *Lomax* v. *Kihara* v. *Von der Ohe,* 175 U.S.P.Q. 538 (D.C. D.C. 1972), the District Court for the District of Columbia denied Von der Ohe's motion to quash the subpoena served on him by Lomax.

Except for *Lomax* v. *Kihara, supra,* all of the above cases involved the procedures for discovery which were superseded by the 1971 Amendments to the Federal Rules of Civil Procedure.

The "old" procedures required that a motion for discovery be brought in a court having jurisdiction over the parties. Thus, when a District Court ordered discovery, the Court was one having subject matter jurisdiction, personal jurisdiction, and one where venue was properly laid.

None of the above cases involved an attempt to take discovery from a nonresident alien under Rule 34 of the Federal Rules of Civil Procedure. Because of this fundamental difference in the fact situation of the present case and those cases cited by Petitioner, it is submitted that there is no conflict among the Circuit Courts of Appeals and, thus, the present case does not warrant granting of the Petition for Writ of Certiorari.

The Court's attention is called to its recent denial on May 19, 1975, of Petitions for Writs of Certiorari in *Frilette et al.* v. *Kimberlin et al.,* No. 74-1156, and *Duffy* v. *Barneset et al.,* No. 74-1200, which involved the place of federal court discovery in a Patent Office Interference.

II.

The Decision of the First Circuit Court of Appeals Was Correct.

The facts of the present case are unique. There is no decision prevailing in any of the Circuits which provides that a nonresident alien can be compelled to produce documents and materials under Rule 34 of the Federal Rules of Civil Procedure in a jurisdiction in which he cannot be subpoenaed, in an ancillary action under 35 U.S.C. 24 for the sole purpose of taking discovery for use in a Patent Office interference. It is, therefore, submitted that the decision of the First Circuit Court of Appeals was correct when it refused to permit Petitioner to take such discovery from Respondents who are nonresident aliens residing in Great Britain.

III.

The Judgment of the First Circuit Court of Appeals Is Correct on Three Additional Grounds Beyond the Specific Reasons Set Forth by That Court for Reaching Its Conclusion.

In addition to the reasons in support of its judgment, there are three other grounds which fully support the First Circuit's judgment below.

Since Respondents are all nonresident aliens residing in Great Britain, both the District Court in Massachusetts and the First Circuit lacked personal jurisdiction over the Respondents. Except for their prior application to the District Court in Massachusetts for a subpoena duces tecum,

Respondents have had no contact with the State of Massachusetts. They do not conduct any business within the state nor do they have any of the minimal contacts required in order to assert personal jurisdiction over them. Under *Babcock & Wilcox Co.* v. *Foster Wheeler Corporation,* only at 174 U.S.P.Q. 145 (D.C. N.J. 1972), a District Court does not gain jurisdiction over a party to a patent interference merely because that party previously applied to that court for discovery.

Secondly, venue was improperly laid in the District Court in Massachusetts because, while 28 U.S.C. 1391(d) provides that an alien may be sued in any district, this statutory provision has been construed to mean that an alien can be sued in any district in which he can be properly served.

28 U.S.C. 1391(d) abrogates the normal venue requirements for the case of an alien since an alien, by definition, neither resides nor conducts business in a particular jurisdiction. 28 U.S.C. 1391(d) provides that an alien can be sued in any district. It is clear from the case law that this section does not literally mean than an alien can be sued in any district that a plaintiff chooses regardless of whether or not the alien can be found there, but rather that an alien can be sued in any district in which valid service of process can be had upon him. In *Sandusky Foundry & Machine Co.* v. *DeLavaud* (1918, D.C. Ohio), 251 F. 631, the District Court stated that an alien could be sued in any district in which he could be served. At page 632, the District Court went on to say,

> "The defendants who have appeared are aliens. It seems to be settled that they are not inhabitants of

any district, and may be sued in any district within which process can be served on them. It was so held under what is now Section 48 of the Judicial Code Act, March 3, 1911, c. 231, 36 State 1100 [Comp. St. 1916, §§1024, 1030], in United Company v. Dupleiss Co. (C.C.), 133 F. 920. . . . The same holding has been repeatedly made under Section 51 of the Judicial Code (Comp. St. 1916, §1033) as applied to causes of action other than suits arising under the patent laws. In re Hohost, 150 U.S. 653, 14 S.Ct. 221; Barrow Steamship Co. v. Kane, 170 U.S. 100, 18 S.Ct. 526. . . . "

Since an alien can only be sued in any district in which he can be validly served, it is believed clear that an alien can only be discovered in a judicial district where he can either be found or with which some nexus exists.

Moore's Federal Practice, Vol. 7B (1972), JC 582 and 583, also discusses Section 1391(d):

"Prior to the Judicial Code revision of 1948 there were no express provisions in the venue statutes which dealt directly with aliens. The courts had forged their venue rules, and decided that inasmuch as an alien was not an 'inhabitant' of any judicial district he could be sued in any district *where valid service of process could be* [sic] *obtained.* [Emphasis added.] And this rule applied equally to individuals as well as to alien corporations. Subsection (d) [of 28 U.S.C. 1391] gives statutory recognition to those propositions."

Thus, an alien may only be sued in any district where valid service of process can be obtained.

Attention is also directed to Barron and Holtzoff, *Federal Practice and Procedure,* Vol. 1, Section 79, page 384 (1960), where it is stated that,

An alien is districtless, and may be sued in any district in which he can be served with process.

In support of this are cited *Niccum* v. *Northern Assur. Co.* (D.C. Ind., 1927), 17 F.2d 160, and *H. G. Baker & Bro.* v. *Pinkham* (D.C. S.C., 1914), 211 F. 728. Attention is also directed to *James Halcott Inc.* v. *Allahabad Bank Limited* (C.A. 5, 1971), 444 F.2d 451, cert. den'd, 404 U.S. 940, 92 S.Ct. 380, which state that 1391(d) has nothing to do with acquiring personal jurisdiction, and that while an alien may be sued for venue purposes in any district in the United States he still has to be properly served with process.

The present fact situation is really one step removed from a plenary action on which venue is posited under 28 U.S.C. 1391(d). The proceeding in the District Court below was alleged to be an ancillary proceeding pursuant to 35 U.S.C. 24, seeking discovery for use in connection with a Patent Office interference. It is believed that the requirements of subject matter jurisdiction, personal jurisdiction over the parties *and* proper venue must all be met, not only in a plenary proceeding, but in an ancillary proceeding under 35 U.S.C. 24. There is no basis either for waiving personal jurisdiction or for disregarding the case law supportive of §1391(d) which requires that an alien can be sued in any federal district where the alien can be found and served. [See also *Best* v. *Great Northern Railway Co.* (D.C. Mont., 1917), 243 F. 789; *Hall* v. *Great Northern Railway*

Co. (D.C. Mont., 1912), 197 F. 488; *Wind River Lumber Co.* v. *Frankfort Marine Accident and Plate Glass Insurance Co.* (D.C. Oregon, 1912), 196 F. 340; *Tierney* v. *Helvetia Swiss Fire Insurance Co.* (C.C. N.Y., 1908), 193 F. 82.]

Petitioner has admitted on page 5 of his Petition for Writ of Certiorari that Respondents cannot be served in Massachusetts.

Thirdly, Petitioner failed to comply with the requirements of Rule 37 of the Federal Rules of Civil Procedure when he moved the Massachusetts District Court for an order directing Respondents to produce the documents and materials sought. Rule 37 expressly requires that a motion to compel discovery must be made to the Court in which *the action is pending.* No action was pending in the District Court for Massachusetts. Therefore, that Court was not the proper Court in which to bring a motion to compel production. Petitioner's action contravenes Rule 37 of the Federal Rules of Civil Procedure by bringing the motion to compel in the wrong Court. This fact coupled with the District Court's lack of personal jurisdiction and the improper laying of venue support the correctness of the decision of the First Circuit.

CONCLUSION

The present case is not one which contains any of the factors customarily considered by this Court as a basis for granting a Petition for Writ of Certiorari.

There is no conflict among the Courts of Appeals because no Court of Appeals has previously come to a contrary decision on a similar fact situation. The present case is unique in that it is the only case involving an attempt by a United States citizen to take discovery from nonresident aliens under Rule 34 of the Federal Rules of Civil Procedure.

Since the fact situation is unique, the present case is not one likely to be encountered or one which will have a far ranging impact on United States law as a whole.

In addition to the reasons set forth by the First Circuit in support of its judgment, there are at least three additional grounds which fully support the conclusions arrived at by the First Circuit in finding that discovery under Rule 34 of the Federal Rules of Civil Procedure was not appropriate against the Respondents. Neither the District Court of Massachusetts nor the First Circuit had personal jurisdiction over Respondents who are nonresident aliens residing in Great Britain. Venue was improperly laid in Boston, Massachusetts. And the motion to compel production was not brought before a Court in which the action was pending as required by Rule 37 of the Federal Rules of Civil Procedure.

It is, therefore, submitted that the Petition for Writ of Certiorari should be denied.

Respectfully submitted,

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Supreme Court, U. S.
FILED
AUG 11 1975
MICHAEL RODAK, JR., CLERK

IN THE

Supreme Court of the United States

October Term, 1974

No. 74-1644

JOHN C. SHEEHAN,

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FRANK P. DOYLE, *et al.*,

Respondents.

PETITIONER'S REPLY BRIEF IN SUPPORT OF HIS PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

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(4399)

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PETITIONER'S REPLY BRIEF IN SUPPORT OF HIS PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

Petitioner submits this Reply Brief to counter arguments first raised in Respondents' Brief in Opposition.

I

The fact that respondents are non-resident aliens does not distinguish the present case from the cases cited by petitioner showing a conflict between the Circuit Courts of Appeals.

Respondents contend that there is no conflict between the Courts of Appeals because the cases cited by Petitioner establishing such conflict are distinguishable because they did not deal with discovery from a *non-resident alien* (respondents are such) under Rule 34 of the Federal Rules of Civil Procedure. We submit that this contention is misleading.

Respondents' contention ignores the clear language of the decision of the Court below which made its ruling as follows:

> "After considering arguments for and against compelling discovery from the nonresident aliens, the district court ordered Doyle and BRL [Beecham] to produce those documents sought that were not priviledged. From this order Doyle now appeals. Doyle objects to the order on the grounds of lack of personal jurisdiction and proper venue, as he is a non-resident alien with no ties to Massachusetts. We do not reach these arguments because we hold that section 24 does not confer jurisdiction upon the district court, acting on its own, to grant Rule 34 discovery directly, *whether against a non-resident alien or a resident citizen.*" [emphasis supplied] Appendix A, page 5a.

Thus, the court below held it was immaterial to its decision that Doyle was a non-resident alien. It follows that the distinction asserted by Respondents is without substantive legal effect and that there is, in fact, a conflict among the Circuit Courts of Appeals for the reasons stated in the Petition.

A recent decision by the Second Circuit Court of Appeals indicates that the conflict will not be resolved in the near future without the intervention of this Court. On July 16, 1975, in the case of *Shattuck* v. *Hoegl,* —— F.2d ——, the Second Circuit ruled on the appealability of discovery orders issued in ancillary proceedings under authority of 35 U.S.C. § 24 in connection with a Patent Office interference. Although the Second Circuit did not comment on the recent limiting construction of 35 U.S.C. § 24 by the First and Third Circuit Courts of Appeals, its ruling

clearly indicates that the jurisdiction of the district court is not to be limited to issuing subpoenas in support of discovery which has been authorized by the Patent Office. Quite to the contrary, the Patent Office Board of Patent Interferences had refused to grant the discovery which the district court subsequently ordered. Although the specific issue resolved by the Second Circuit is only peripherally related to that which has been raised by Petitioner, the case is positive evidence that a conflict does exist between the circuits on the construction of 35 U.S.C. § 24.

II

The present fact situation is not "unique", but has been considered by the Third Circuit Court of Appeals and is likely to arise again.

In urging that this case does not warrant certiorari Respondents state on page 6 of the Brief in Opposition:

> "The facts of the present case are unique. There is no decision *prevailing* in any of the Circuits which provides that a nonresident alien can be compelled to produce documents and materials under Rule 34 of the Federal Rules of Civil Procedure in a jurisdiction in which he cannot be subpoenaed, in an ancillary action under 35 U.S.C. §24 for the sole purpose of taking discovery for use in a Patent Office interference. It is, therefore, submitted that the decision of the First Circuit Court of Appeals was correct when it refused to permit Petitioner to take such discovery from Respondents who are nonresident aliens residing in Great Britain." [emphasis supplied]

and further on page 11:

> "There is no conflict among the Courts of Appeal because *no* Court of Appeals has previously come to a

> contrary decision on a similar fact situation. The present case is unique in that it is the only case involving an attempt by a United States citizen to take discovery from nonresident aliens under Rule 34 of the Federal Rules of Civil Procedure." [emphasis supplied]

The first statement is misleading and the second statement is simply not true.

Respondents ignore and fail to inform this Court of the decision of the Third Circuit Court of Appeals in *Vogel* v. *Jones,* 443 F.2d 257 (1971) in which a fact situation indistinguishable from the present one was considered and document discovery was ordered.

Indeed, *Vogel* v. *Jones,* which reflected the then prevailing view that 35 U.S.C. § 24 was to be construed broadly, was relied upon by Judge Garrity in his opinion in the U.S. District Court below granting Sheehan's requested discovery, in which opinion (dated August 9, 1974) he stated (Appendix C, page 10a):

> "In our view these proceedings are not materially different from those in Vogel v. Jones 3 Cir. 1971, 443 F.2d 257."

There is no material difference between the situation presented to the District Court below and that of *Vogel* v. *Jones.* In the *Vogel* case, Vogel (read Sheehan), a party to a patent interference proceeding, sought to obtain production of *documents only* under Rule 34 from the other party to the interference Jones (read Doyle et al.) and ICI, Ltd. (read Beecham Research Laboratories, Ltd.), the

corporate employer-assignee of the Jones (Doyle et al.) patent application. Vogel was a resident of Minnesota (Sheehan is a resident of Massachusetts). Both Jones and ICI were aliens residing in Great Britain (Doyle et al. and Beecham are aliens residing in Great Britain). The Vogel discovery was commenced in the District Court of the District of New Jersey under authority of 35 U.S.C. § 24 by filing a "Notice of Ancillary Proceedings for Discovery under 35 U.S.C. § 24" and a request for production of documents by Jones and ICI and serving the Notice and request on the parties and their counsel (Sheehan commenced his discovery under §24 in the District Court for the District of Massachusetts by filing a similar notice and request and serving them in the same manner).

The District Court of New Jersey dismissed the discovery proceedings for lack of personal jurisdiction over Jones and ICI. The Third Circuit reversed. In response to the arguments by Jones and ICI that the court lacked *in personam* jurisdiction, the Third Circuit held that personal jurisdiction attached when the alien parties filed the interfering patent application in the Patent Office. Thus, when the ancillary discovery provisions of Section 24 are taken with 28 U.S.C. § 1391(d), which provides that an "alien may be sued in any district", production of documents can be ordered by any federal district court upon proper motion by the opposing party. Having found that the federal district court in New Jersey had sufficient personal jurisdiction over the parties to compel production of documents, the Third Circuit then determined that requirements of due process had also been met by the service of the notice upon all the parties and their counsel.

The later decision in 1975 of the Third Circuit Court of Appeals in *Frillette et al.* v. *Kimberlin et al.*, 508 F.2d 205 (*en banc*), reversing its prior decisions giving a broad construction of 35 U.S.C. § 24 and adopting a narrow construction, in our view did not overrule *Vogel* v. *Jones* on the basis of the involvement of a non-resident alien, but only insofar as the discovery sought did not meet the new narrow construction of having been authorized by the Patent Office.

If this Court were to grant the Petition and to rule that the First Circuit Court had erred in its construction of 35 U.S.C. § 24, we believe that such ruling would likewise apply to the Third Circuit's decision in *Frillette*, and would have the effect of reinstating the earlier decisions of the Third Circuit, including *Vogel* v. *Jones*. While not controlling on other circuits, these decisions would undoubtedly be of great influence in deciding like or similar questions.

Thus, the present fact situation is not "unique" as alleged by Respondents in their Brief in Opposition, but is indistinguishable from that presented in *Vogel*. Moreover, in view of the large number of patent applications filed in the United States Patent and Trademark Office by, or on behalf of, non-resident aliens it cannot be denied that similar patent interference-related discovery issues are likely to be raised.

Conclusion

For the above reasons and those previously presented by petitioner we respectfully request that the petition be granted.

Respectfully submitted,

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